

Application No. 09/783,997

Reply to Office Action of August 26, 2003

REMARKS/ARGUMENTS

Favorable reconsideration of this application is respectfully requested.

Claims 13-31 are pending, Claims 27-31 having been previously withdrawn from consideration.

In the outstanding Office Action, Claims 13-16, 18-23 and 25 were rejected as being unpatentable over JP 2000/344,353, (hereinafter JP '353); Claim 17 was rejected as being unpatentable over JP '353 in view of Kim (U.S. Patent No. 6,009,060) and Claims 24 and 26 were rejected as being unpatentable over JP '353 in view of Goto et al. (U.S. Patent No. 6,307,828).

The invention of Claim 13 is directed to a disc support plate that includes a substrate and a resin portion. The resin portion is provided only on the first edge portion, the second edge portion and a line-shaped portion between the first edge portion and the second edge portion of the substrate. Support for this claim is found, for example, in Figure 4 of the present patent application. A first edge portion corresponds with Figure element 2c, the second edge portion 2d, and the line-shaped portion 2e. As there are a number of embodiments covered by this claim it is respectfully submitted that this example of Figure 4 is a non-limiting example.

JP '353 is directed to a compact disc tray that consists of stainless steel plate (23b) which is insert molded in-between soft synthetic resin layers (23c). The advantage as identified in JP '353 is that the manufacturing process becomes simple and economical due to the simple molding process.

Applicants respectfully traverse the rejection of Claim 13 as being obvious over JP '353. The basic requirements for a *prima facie* case of obviousness are (1) there must be some suggestion or motivation in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine the

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reference teachings, (2) there must be a reasonable expectation of success, and (3) the prior art reference must teach or suggest all the claim limitations. It is respectfully submitted that the outstanding Office Action fails to make a *prima facie* case of obviousness, because there is no suggestion or motivation to modify the reference since the proposed modification asserted in the outstanding Office Action, would render the device of JP '353 unfit for its intended purpose, and would change the principle of operation of JP '353.

JP '353, is quite specific in that it relies on an insert molding process in which a stainless steel plate is insert molded between soft synthetic resin layers. This manufacturing process is critical to JP '353 because JP '353 expressly states that the "manufacturing becomes simple and economical due to simple molding process". (JP '353 "advantage" portion of English summary sheet). Moreover, it is clear from the teaching in JP '353, that it relies upon an insert molding process in order to form and then hold the stainless steel plate.

If the device in JP '353 is to be like the structure as defined in Claim 13 (namely having a resin portion only on the first edge portion, the second edge portion and a line-shaped portion between the first edge portion and the second edge portion), this would change the principle of operation for the disc in JP '353. Furthermore, the proposed modification would render JP '353 unfit for its intended purpose, which is to manufacture the device simply and economically due to the simple molding process. Moreover, if the only resin portions were formed on the first edge portion, second edge portion and line-shaped portion, as claimed in Claim 13, while attempting to use an insert molding" process as required in JP '353, the amount of resin will be insufficient in order to insert mold a stainless steel plate between resin "layers". Moreover, JP '353 is quite specific that it requires "layers" (see English abstract and the cover figure in JP '353). Accordingly, it is not possible, without changing the principle of operation of the device in JP '353, to use the resin portions provided "only on" (as claimed in Claim 13) a first edge portion, second edge

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portion and long-shaped portions in order to develop the device described in JP '353. Rather, JP '353 actually teaches away from the presently claimed invention because it requires the use of layers in the molding process and uses the entire resin layers to insert-mold the stainless steel plate. Thus, it is respectfully submitted that the present rejection is based on improper hindsight reasoning (M.P.E.P. § 2145(X)) and a *prima facie* case of obviousness has not been made. Consequently it is respectfully submitted that Claim 13 patentably defines over the admitted prior art. It is respectfully submitted the same argument with regard to Claim 13 also applies to rejected Claims 14-16, 18-23 and 25, therefore these claims also patentably define over JP '353.

Claims 17, 24 and 26 are rejected based on the analysis described above with regard to Claim 13 regarding JP '353 in view of secondary references. However, the secondary references merely teach features which are absent in JP '353, and do not otherwise cure the deficiencies discussed above with regard to JP '353 in view of Claim 13. Consequently, it is respectfully submitted that Claims 17, 24 and 26 also patentably define over the asserted prior art.

Consequently, in view of the present amendment and in light of the foregoing comments, it is respectfully submitted that the invention defined by Claims 13-26 patentably

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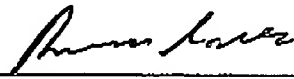
define over the prior art. The present application is therefore believed to be in condition for formal allowance and an early and favorable reconsideration of this application is therefore requested.

Respectfully submitted,

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